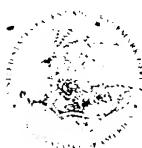


MAY 10 2002



Shelly Guest Cermak
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In re Application of : DECISION ON PETITION
SCHAEFFER, et al. :
U.S. Application No.: 10 009,527 :
PCT No.: PCT EP00 05313 : UNDER 37 CFR 1.47(a)
Int. Filing Date: 08 June 2000 :
Priority Date: 08 June 1999 :
Attorney Docket No.: 0273-0004 :
For: BIOLOGICAL JOINT CONSTRUCT :
:

This decision is in response to applicant's "Declaration of Facts by Attorney For Inventor That Cannot be Located" filed 10 December 2001 in the United States Patent and Trademark Office (USPTO). The declaration is being treated as a petition under 37 CFR 1.47(a).

BACKGROUND

On 08 June 2000, applicants filed international application PCT EP00 05313, which claimed priority of an earlier application filed 08 June 1999. A copy of the International Application was forwarded to the United States Patent and Trademark Office (USPTO) from the International Bureau (IB) on 14 December 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 15 December 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 08 December 2001.

On 10 December 2001, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(e)(1); a translation of the International Application into English; a Preliminary Amendment; a copy of the International Preliminary Examination Report; a copy of the International Search Report; an Information Disclosure Statement; a combined declaration and power of attorney executed by joint inventors: Dirk SCHAEFFER; Christof KENT and Gerhard STARK accompanied by a declaration of facts regarding the lack of signature of joint inventor Hans-Peter FRIEDL. As 08 December 2001 was a Saturday, payment of the full U.S. basic national fee was made on the next business day and was thus considered timely paid.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(l), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to Item (1), applicants have authorized the charging of any additional fees to Deposit Account No.: 50-0622. Therefore, \$130.00 will deducted as payment of the petition fee for a petition under 37 CFR 1.47(a).

As to Item (4), accompanying the petition is a declaration signed by the remaining inventors on their behalf, and on behalf of the non-signing inventor. Accordingly, Items (1) and (4) have been satisfied.

As to item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Applicants allege that inventor Friedl cannot be found or located. However, no documentary evidence to support the failed attempts was provided with Shelly Guest Cermak's declaration. Applicants have not provided any information as to whether a search of telephone directories or Internet search engines were performed in an attempt to find a current address for

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Mr. Friedl.

Regarding Item (3), the declaration of Shelly Guest Cermak states that, "no new forwarding address has yet been identified." As such, applicant's have not provided a statement detailing the last known address of Mr. Friedl.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED, without prejudice.**

Applicants are hereby afforded TWO (2) MONTHS from the mail date of this decision to file either 1) an oath or declaration in compliance with 37 CFR 1.497(a)-(b) signed by all inventors or 2) a renewed petition satisfying all requirements under 37 CFR 1.47(a). Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.


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